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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,260	08/14/2006	Luca Doglioni Majer	367769US91PCT	2431
22850	7590	12/09/2010	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.			WILLIAMS, LELA	
1940 DUKE STREET				
ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER
			1789	
			NOTIFICATION DATE	DELIVERY MODE
			12/09/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/585,260	Applicant(s) DOGLIONI MAJER, LUCA
	Examiner LELA S. WILLIAMS	Art Unit 1789

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 30 September 2010.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 7-14 and 18-26 is/are pending in the application.
 4a) Of the above claim(s) 1-6 and 15-17 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 7-14 and 18-26 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/06)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

1. Applicant's amendment filed September 30, 2010 has been fully considered, however the amendment necessitated the new grounds of rejection set forth below. Therefore, the following action is made final.

Claim Objections

2. Claims 23-25 objected to because of the following informalities: the claims state according to claims 8, 9, and 12, respectively, in the second line of each claim. Applicant is advised to place said language in line one of each claim, i.e. "*[t]he capsule according to claim 8 for ...*" Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Paragraph 0050 of the specification details deforming the capsule outwardly; however there is no support for the present claim language of "...wherein said dispensing wall is configured to move outwardly relative to an interior of the capsule."

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claims 7-14, 21, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardin et al. EP 1243210.**

Regarding claim 7, Bardin discloses a beverage capsule for the preparation of a beverage obtained by supplying water within the capsule (abstract) having a dispensing wall and lid portion (figure 6, item 23) which opens to discharge the liquid. The lid portion is said to open inward as a mechanical reaction force is applied from the outside, thereby varying the area of the dispensing area while it is opening. The reference is silent to varying an area of the dispensing opening at least twice; however the lid is on a folding means which is opened by a mechanical force applied from outside the capsule, once the beverage starts dispensing and force is no longer applied, the force of gravity will naturally enable the opening member to vary at least twice during dispensing the beverage from the capsule.

Alternatively, given that the mechanical force which is applied from outside of the lid pushes on the opening, making it travel upwards, the area of the dispensing opening will naturally change at least twice during dispensing of the beverage.

Regarding claims 8 and 9, given the disclosure of the folding means “is adapted to cause the opening member to fold upon action of said reaction force”, meaning the folding means is acting as a joint holding the lid portion and wall portion so that the lid can swing, it is a

hinge [0007, 0009, 0017] and would naturally function to impart an oscillating movement to the wall during the dispensing step.

Regarding claims 10 and 21, as discussed above, Bardin comprises a hinge means attached to the dispensing wall of the capsule. The reference discloses that once the water stops' entering the capsule and the plunger separates, the capsule substantially or partially recovers to its initial dimension (col. 9, line 30-35). Given this disclosure one of ordinary skill would reasonably expect and find it obvious that the lid portion would also close at least partially, because the pressure is no longer applied and there is no outside force acting on it.

Regarding claims 11, Bardin is applied to claim 7 as discussed above. The reference discloses a capsule which is able to withstand the pressure of an extraction system [0021]; however the reference does not disclose the rigidity of the capsules as measured by a punch. Given Bardin's teaching of constructing a capsule with "pressure resistant but elastically deformable material" it would have been obvious to one of ordinary skill in the art at the time of the invention to construct a capsule with enough rigidity, including that presently claimed, to withstand the pressure of the extraction system, which it is to be utilized. Furthermore, the selection of a known material based on its suitability for its intended use supports a *prima facie* obviousness as determined in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (see MPEP 2144.07). Therefore, it would have been obvious to one or ordinary skill in the art to use a suitable material for the use of an extraction system.

Regarding claim 12, Bardin discloses a beverage capsule for the preparation of a beverage obtained by supplying water within the capsule (abstract) having a dispensing wall and

lid portion (figure 6, item 23) which opens to discharge the liquid. The reference discloses a capsule which is able to withstand the pressure of an extraction system [0021]; however the reference does not disclose the rigidity of the capsules as measured by a punch. Given Bardin's teaching of constructing a capsule with "pressure resistant but elastically deformable material" it would have been obvious to one of ordinary skill in the art at the time of the invention to construct a capsule with enough rigidity, including that presently claimed, to withstand the pressure of the extraction system, which it is to be utilized. Furthermore, the selection of a known material based on its suitability for its intended use supports a *prima facie* obviousness as determined in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (see MPEP 2144.07). Therefore, it would have been obvious to one or ordinary skill in the art to use a suitable material for the use of an extraction system. The reference is silent to varying an area of the dispensing opening at least twice; however the lid is on a folding means which is opened by a mechanical force applied from outside the capsule, once the beverage starts dispensing and force is no longer applied, the force of gravity will naturally enable the opening member to vary at least twice during dispensing the beverage from the capsule.

Alternatively, given that the mechanical force with is applied from outside the lid pushes on the opening, making it travel upwards, the area of the dispensing opening will naturally change at least twice during dispensing of the beverage.

Regarding claims 13, 14, and 22, Bardin is applied as discussed above. The reference discloses a capsule which has an area capable of being opened to allow fluid to pass [0009]. Although the reference does not disclose the thickness of the surrounding wall, it would have

been obvious to one of ordinary skill in the art at the time of the invention to construct a capsule wherein the thickness of the opening portion is greater than its surrounding walls, to withstand the force which is applied to it and not break off in the process. The reference is also silent concerning the angle of inclination; however figure 5 of Bardin shows a capsule which does not have a flat bottom, thereby resulting in an angle of inclination. It is noted that said angle is not expressly disclosed, however given that applicant has not demonstrated the criticality of said angle and any changes in shape are considered "a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant." *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (see MPEP 2144.04 IV.B). Therefore, it would have been obvious to one of ordinary skill in the art to determine a suitable shape.

Regarding claim 26, Bardin discloses a beverage capsule for the preparation of a beverage obtained by supplying water within the capsule (abstract) having a dispensing wall and lid portion (figure 6, item 23) which opens to discharge the liquid. The lid portion is said to open inward as a mechanical reaction force is applied from the outside, thereby varying the area of the dispensing area while it is opening. The reference is silent to varying an area of the dispensing opening at least twice; however the lid is on a folding means which is opened by a mechanical force applied from outside the capsule, once the beverage starts dispensing and force is no longer applied, the force of gravity will naturally enable the opening member to vary at least twice during dispensing the beverage from the capsule.

Alternatively, given that the mechanical force which is applied from outside of the lid pushes on the opening, making it travel upwards, the area of the dispensing opening will naturally change at least twice during dispensing of the beverage.

Given the disclosure of the folding means “is adapted to cause the opening member to fold upon action of said reaction force”, meaning the folding means is acting as a joint holding the lid portion and wall portion so that the lid can open, it is a hinge [0007, 0009, 0017].

7. Claims 18-20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardin et al. EP 1243210 in view of Hale U.S Pat. No. 6,810,788.

Regarding claims 18, 19, 23, 24, 25, Bardin discloses a capsule for preparing a beverage from food substance within said capsule (abstract) having a dispensing wall and lid portion which opens inward as a mechanical reaction force is applied from the outside, to discharge the liquid, as applied to claims 7 above. Bardin, however does not disclose a filter element. Hale discloses a beverage cartridge and filter assembly wherein the filter components are spaced apart from the bottom wall by being coupled to the sloped step about an outer edge (Fig 4, 50 & col. 3, lines 55-65). Although Hale does not disclose the outer edge to be a "spacer", the edge does function as so. Given Hale's teaching that the filter bows when in use and the bottom wall provides support for the filter (col. 5, lines 24-30), one of ordinary skill would have been motivated to not only use a filter in the invention of Bardin, but to space the filter apart from the bottom wall of the capsule to ensure the filter does not fall apart during the beverage making process.

Regarding claim 20, Bardin teaches that as water enters the capsule, the inside pressure starts to build and deforms the capsule outwardly [0030].

Response to Amendment

8. Claims 7-14 and 18-26 are currently pending. Claims 1-6 and 15-17 are withdrawn.
9. Applicant's amendment filed September 30, 2010 is sufficient to overcome the 35 U.S.C §112, second paragraph rejections of the previous office action. Therefore the rejection has been withdrawn.
10. Applicant's amendment is sufficient to overcome the 35 U.S.C §102(b), rejections of the previous office action. Therefore the rejection has been withdrawn.

Response to Arguments

11. Applicant's arguments, with respect to the 35 U.S.C §102(b) rejection of Bardin and 35 U.S.C §103(a) of Bardin in view of Fond have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of 35 U.S.C §103(a) rejection is made in view of Bardin and Bardin in view of Hale.

Applicant's argument that Bardin does not disclose that an area of its dispensing opening changes in area at least twice during dispensing of a beverage, does not impart oscillation (page 10), and that the reference teaches away from such movement are noted; however, Bardin may disclose it is preferred that the lid remains open so all the beverage is dispensed; however, the lid is on a hinge type folding means which is opened by a mechanical force applied from outside. Once that force is no longer applied, the force of gravity will naturally enable the opening

member to recover, at least some. Bardin may disclose the opening has the "ability" to remain open and does not return to its original position but given the effect of gravity as well as the disclosure of the capsule itself substantially or partially recovering to its initial dimension, it is obvious that the opening member of Bardin will naturally move in an oscillating manner. Although the opening may not recover to the point of its initial position, it will be sufficient to be described as "at least twice during dispensing".

Alternatively, given that the mechanical force which is applied from outside of the lid pushes on the opening, making it travel upwards, the area of the dispensing opening will naturally change at least twice during dispensing of the beverage. Therefore, it would have been obvious to one of ordinary skill that although the reference may disclose it is preferred for the lid to remain open in order for all the beverage to dispense, the opening will partially change at least twice during dispensing.

Regarding applicant's argument to the inherency of the lids oscillating movement, note that the examiner's position remains that such oscillation will necessarily occur and that while applicants argue that such feature would not be inherent, they have provided no evidence to support this position.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LELA S. WILLIAMS whose telephone number is (571)270-1126. The examiner can normally be reached on Monday to Thursday from 7:30am-5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LELA S. WILLIAMS
Examiner, Art Unit 1789

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